

## REMARKS

The Office Action dated July 6, 2007 has been received and carefully considered. Reconsideration of the outstanding rejection in the present application is respectfully requested based on the following remarks.

### Section 101 Rejection of Claims 42-54 and 56

At page 2 of the Office Action, claims 42-54 and 56 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. This rejection is hereby respectfully traversed.

At pages 2-3 the Office Action asserts that claims 42-54 and 56 are not directed to statutory subject matter because claim 42, from which claims 43-54 and 56 depend, recites a “computer readable medium” and because “the instant application discloses that a ‘computer readable medium’ may be a signal.” According to the Office Action, “a claim reciting a signal encoded with functional descriptive material [does not fall] within any of the categories of patentable subject matter set forth in § 101. The Office Action does not provide any support for this assertion. However, even assuming *arguendo* that this statement is correct, Applicant respectfully submits that the computer readable medium recited in claim 42 is not directed to a signal encoded with functional descriptive material. As a first issue, one skilled in the art would not understand the term “computer readable medium” to include an electromagnetic signal. Further, the specification would not change this understanding. The specification, at page 18, line 25 – page 19, line 6 states that a signal may be used to **transfer instructions from one computer readable medium to another**. In particular, the specification states “a signal may be a composite signal comprising a carrier signal, and contained within the carrier signal is the desired information containing at least one computer program instruction implementing the invention...one skilled in the art would appreciate that the...**transfer** of the sets of instructions...changes the **medium upon which it is stored**.” *Specification*, page 18, line 25 – page 19, line 6 (emphasis added). Thus, a signal can be used to transfer computer readable information, which can result in a change in a computer readable medium. However, the signal

itself is not a computer readable medium. Accordingly, claims 42-54 and 56 are directed to statutory subject matter.

In view of the foregoing, it is respectfully submitted that the § 101 rejection of claims 42-54 and 56 is improper. Withdrawal of the rejection and reconsideration of the claims is respectfully requested.

#### **Anticipation Rejection of Claims 16-21 and 27**

At page 3 of the Office Action, claims 16-21 and 27 are rejected under 35 U.S.C. § 102(e) as being anticipated by Begeja et al. (U.S. Patent Publication No. 2003/0163815 A1). This rejection is hereby respectfully traversed.

Begeja discloses a system for extracting multimedia clips from a source of multimedia content based on search terms and a content source. *Begeja*, Abstract. A user can enter search terms and sources of content that should be searched. *Id.* [0062]-[0064]. The system retrieves clips based on the search terms and provides an option to the user to display the clips.

Turning to the claims, claim 16 recites “providing content...to the remote device **based on a set of user-specific parameters**” (emphasis added). These elements are not disclosed or suggested by Begeja. As explained above, Begeja discloses **locating** content based on user defined search terms and content sources. Begeja does not disclose that the content is **provided** based on a set of user-specific parameters. That is, even assuming *arguendo* that the search terms and content sources disclosed by Begeja are “user-specific” parameters, Begeja does not disclose that **the way in which clips are provided** is based on the search terms, the content sources, or any other user-specific parameters. Accordingly, Begeja fails to disclose each and every element of claim 16.

Claims 17-21 and 27 depend from claim 16. Accordingly, Begeja fails to disclose each and every element of claims 17-21 and 27, at least by virtue of their dependency on claim 16. In addition, claims 17-21 and 27 recite additional novel elements.

In view of the foregoing, it is respectfully submitted that the anticipation rejection of claims 17-21 and 27 is improper. Withdrawal of the rejection and reconsideration of the claims is respectfully requested.

#### **Obviousness Rejection of Claims 22-25**

At page 4 of the Office Action, claims 22-25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Begeja et al. in view of Boies et al. (U.S. Patent Publication No. 2002/0194011 A1). This rejection is hereby respectfully traversed.

Claims 22-25 depend from claim 16. As explained above, Begeja fails to disclose or suggest each and every element of claim 16. Further, Boies does not remedy the deficiencies of Begeja. Accordingly the cited references, individually and in combination, fail to disclose or suggest each and every element of claims 22-25, at least by virtue of their dependence on claim 16. In addition, claims 22-25 recite additional novel elements.

To illustrate, claim 23 recites “wherein the set of user specific parameters includes a parameter indicating that the content should be provided as a still image representative of the first portion of the stored video content.” According to the Office Action at page 6, these elements are disclosed by Boies at paragraph [0036]. Boies discloses a system for selecting an information presentation format based on an individual’s “limitations.” Boies, Abstract and FIG. 6. The Boies system automatically determines a format based on the limitations it determines. *Id.* Thus, Boies does not disclose a parameter indicating that content should be provided as a still image. Instead, Boies discloses determining a presentation format based on a set of determined individual limitations. That is, assuming *arguendo* that Boies discloses parameters, these parameters do not indicate a particular format for presenting content, but instead indicate individual limitations. Further, there is no disclosure or suggestion in Boies that a particular individual limitation indicates that content should be provided as a still image. Moreover, Begeja does not remedy the deficiency of Boies. Accordingly, the cited references fail to disclose each and every element of claim 23.

In view of the foregoing, it is respectfully submitted that the obviousness rejection of claims 22-25 is improper. Withdrawal of the rejection and reconsideration of the claims is respectfully requested.

**Obviousness Rejection of Claims 1-13, 15, 28-39, 41-54 and 56-59**

At page 8 of the Office Action, claims 1-13, 15, 28-39, 41-54 and 56-59 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Begeja et al. in view of Tracton et al. (U.S. Patent No. 6,470,378 B1). This rejection is hereby respectfully traversed.

Tracton discloses a system for changing the level of content provided to a client based on network parameters. *Tracton*, col. 5, lines 47-65. A server scales the source content based on these parameters. *Id.* Thus, Tracton discloses a system for translating content based on network parameters.

Turning to the claims, claim 1 recites “identifying a first portion of the stored video content...based on a bandwidth capability of a remote device.” These elements are not disclosed or suggested by the cited references. The Office Action acknowledges at page 9 that these elements are not disclosed by Begeja. The Office instead relies upon Tracton as disclosing these elements. However, as explained above, Tracton discloses translating content based on network parameters. Tracton does not disclose identifying a portion of video content based on bandwidth capability. That is, Tracton discloses translating content based on network parameters after the content has already been identified. There is no disclosure that the Tracton system uses a bandwidth capability of a remote device to identify content to be translated. Accordingly the cited references, individually and in combination, fail to disclose or suggest “identifying a first portion of the stored video content...based on a bandwidth capability of a remote device.”

Claim 28 recites “a content server to select of first portion of the stored video content...based on a bandwidth capability of a remote device.” As explained above, the cited references fail to disclose or suggest selecting video content based on a bandwidth capability of a remote device. Accordingly, the cited references necessarily fail to disclose or suggest a content server that selects video content based on a bandwidth capability of the remote device. Thus, the cited references fail to disclose or suggest each and every element of claim 28.

Claim 42 recites “instructions to... identifying a first portion of the stored video content...based on a bandwidth capability of a remote device.” As explained above, the cited references fail to disclose or suggest identifying video content based on a bandwidth capability of a remote device. Accordingly, the cited references necessarily fail to disclose or suggest instructions to identify video content based on a bandwidth capability of a remote device. Thus, the cited references fail to disclose or suggest each and every element of claim 42.

Claims 2-13, 15, 57, and 58 depend from claim 1. Claims 29-39 and 41 depend from claim 28. Claims 43-54 depend from claim 42. Accordingly, the cited references fail to disclose or suggest each and every element of claims 2-13, 15, 29-39, 41, 43-54, and 57-58, at least by virtue of their respective dependency on claims 1, 28, and 42. In addition, claims 2-13, 15, 29-39, 41, 43-54, and 57-58 recite additional novel elements.

To illustrate, claim 58 recites “providing content in a format...based on a set of user-specific parameters.” The Office Action relies upon Tracton as disclosing these elements. As explained above, Tracton discloses translating content based upon network parameters. Tracton does not disclose translating content based on parameters that are specific to a particular user. Accordingly, the cited references fail to disclose or suggest each and every element of claim 58.

With respect to claim 59, the claim depends from claim 16. As explained above, Begeja fails to disclose each and every element of claim 16. Further, Tracton does not remedy the deficiency of Begeja. Accordingly, the cited references fail to disclose each and every element of claim 59, at least by virtue of its dependency on claim 16. In addition, claim 59 recites additional novel elements.

In view of the foregoing, it is respectfully submitted that the obviousness rejection of claims 1-13, 15, 28-39, 41-54, and 56-59 is improper. Withdrawal of the rejection and reconsideration of the claims is respectfully requested

## **Conclusion**

The Applicant respectfully submits that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone

number in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

The Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to Deposit Account Number 50-0441.

Respectfully submitted,

/Adam D. Sheehan/

Adam D. Sheehan; Reg. No. 42,146

LARSON NEWMAN ABEL POLANSKY & WHITE, LLP

5914 West Courtyard Drive, Suite 200

Austin, Texas 78730

(512) 439-7100 (phone)

(512) 439-7199 (fax)

August 14, 2007

Date